

Rev. 10/1/03

2652

AMENDMENT TRANSMITTAL LETTER			Attorney Docket Q01-1025-US1 / 11198.64
Application Serial Number:	Filing Date:	Examiner:	Group Art Unit:
09/823,236	March 30, 2001	David D. Davis	2652
Invention: MAGNETIC SHIELD FOR THE DRIVE HOUSING OF A RECORDING DRIVE			
TO THE COMMISSIONER OF PATENT AND TRADEMARKS:			
Transmitted herewith is an amendment in the above-identified application. The fee has been calculated as shown below.			
CLAIMS AS AMENDED			
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR
			NUMBER OF EXTRA CLAIMS PRESENT
			RATE
			ADDITIONAL FEE
TOTAL CLAIMS	33	MINUS	33
			0
			\$18
			\$0
INDEP. CLAIMS	6	MINUS	6
			0
			\$86
			\$0
<p>Petition is hereby made under 37 CFR 1.136(a) to extend the time for response to the Office Action of _____ to and through _____, comprising an extension of the shortened statutory period of:</p> <p>_____ one month (\$110)      _____ three months (\$950) _____ two months (\$420)      _____ four months (\$1,480)</p>			
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT			\$0
<p>Small entity status of this application under 37 CFR 1.9 and 1.27 has been established by a verified statement previously submitted.</p> <p>A check in the amount of \$ _____ [which includes \$ _____ for the _____] is enclosed.</p> <p><input checked="" type="checkbox"/> The commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 50-1141, pertaining to 1) any filing fees under 37 CFR 1.16 for the presentation of extra claims; 2) any patent application processing fees under 37 CFR 1.17.</p> <p><input checked="" type="checkbox"/> Any additional extension of time required for the timely submission of this paper, the fees for which have not been previously paid, is hereby petitioned for and requested.</p> <p>11/06/2003 Date</p> <p> James P. Broder, Reg. No. 43,514</p>			
CERTIFICATE OF MAILING: I hereby certify that this correspondence and all correspondence identified as accompanying this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Mail Stop No Fees, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on November 6, 2003.			
 James P. Broder, Reg. No. 43,514			

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PATENT

#18  
MOY  
11/18/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:      Nguy  
Serial No:                    09/823,236  
Filed:                        March 30, 2001  
For:                         Magnetic Shield for the Drive Housing  
                                 of a Recording Drive (As Amended)  
Examiner:                  Davis, David D.  
Attorney Docket:          Q01-1025-US1/11198.64

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) Art Unit  
) 2652  
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**RESPONSE TO RESTRICTION REQUIREMENT**

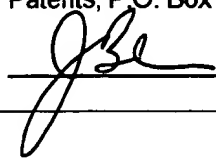
Mail Stop No Fees  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the Restriction Requirement dated October 8, 2003, having a one-month shortened statutory period for response set to expire on November 8, 2003, the Applicant responds as follows:

**CERTIFICATE OF MAILING UNDER 37 CFR §1.8**

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to: Mail Stop No Fees, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this the 6<sup>th</sup> day of November, 2003.



JAMES P. BRODER, Attorney for Applicant—Registration No. 43,514

858-487-4077

## **ELECTION**

The Applicant respectfully elects with traverse Group II, including claims 10, 29-36, 39-44 and 47-50, which the Patent Office has determined are "a housing attenuating a field."<sup>1</sup>

## **ARGUMENT**

The Applicant respectfully traverses the election requirement. The Patent Office has delineated two groups of inventions as follows: Group I: "Claims 26, 38, 37, 45 and 46, drawn to a housing shield attenuating a field and having a material with a relative permeability"; Group II: "Claims 10, 29-30 and 48-50, drawn to a housing attenuating a field"; and Group III: "Claims 16-24, drawn to a housing having a material with a relative permeability". As provided previously, the Applicant submits that the Group II claims should also include claims 31-36, 39-44 and 47, which each requires that the housing attenuates a field.

Further, the Patent Office has determined that "Inventions I and II are related as combination and subcombination.... In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination has housing shield portions formed from material having a relative permeability of at least approximately 100,000. The subcombination has separate utility such as providing an attenuation of field of at least 25 dB that at least partially shields the storage surface from an external magnetic field that is applied in a direction that is substantially perpendicular to the storage surface." The Applicant submits that the restriction requirement is improper and should be withdrawn as explained below.

At least some of the claims indicated by the Patent Office to be included in Group I require the particulars of at least some of the Group II claims. Because of this similarity in particulars in each respective grouping of claims, at least some of the claims of Group I do not have separate utility from at least some of the claims of Group II. Stated another way, some of the Group I claims require a specific attenuation of field, which is the

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<sup>1</sup> The Applicant believes this is a typographical error by the Patent Office, and that Group II should include claims 10, 29-36, 39-44 and 47-50.

distinguishing characteristic of a Group II claim. For example, claim 26 of Group I is directed toward a "disk drive ... comprising ... a housing shield having an attenuation of field of at least approximately 50 dB ...".

In another example, claim 37 of Group I is directed toward a "disk drive of claim 29 wherein ...". In other words, claim 37 (Group I) depends from claim 29 (Group II). Therefore, because claim 37 includes at least some of the particulars of claim 29 (Group II), claim 37 should be examined with the Group II claims. Further, claim 38 (Group I) depends from claim 29 (Group II). Thus, these claims should be examined together.

Somewhat similarly, the claims indicated by the Patent Office to be included in Group I include particulars of the Group III claims. Because of this similarity in particulars in each respective grouping of claims, at least some of the claims of Group I do not have separate utility from at least some of the claims of Group III. For instance, claim 26 (Group I) is directed toward a disk drive having a housing shield that requires that "each of the shield portions is formed from material having a relative permeability of at least approximately 100,000." Claim 18 (Group III) requires that "the housing shield is substantially formed from material having a relative permeability of at least approximately 100,000." In other words, both claim 18 (Group III) and claim 26 (Group I) are drawn to a housing having a material with a relative permeability. Therefore, these claims should be examined together.

Moreover, the Patent Office states that "the search required for Groups II and III is not required for Group I ...". The Applicant respectfully disagrees with this statement on the basis that, as defined by the Patent Office, Group I requires "a housing shield attenuating a field and having a material with a relative permeability", which includes the characteristic attenuation of field of Group II and the characteristic relative permeability of Group III, as these groups are defined by the Patent Office. Therefore, to search Group I, according to the definitions set forth by the Patent Office, a search of both "attenuation of field" (Group II) and "relative permeability" (Group III) is required.

Based on the foregoing, the Applicant asserts that the election requirement should be withdrawn.